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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,126	10/03/2000	John Newlin	083818 0269851	6144

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EXAMINER
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STEELMAN, MARY J

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 05/12/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/680,126

Applicant(s)

NEWLIN ET AL.

Examiner

Mary J. Steelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12/05/00,02/09/01.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. Claims 1-20 are pending.

### ***Specification***

2. Remove the Appendix from the Specification.

#### **GUIDELINES FOR DRAFTING A NONPROVISIONAL PATENT**

#### **APPLICATION UNDER 35 U.S.C. 111(a)**

The following guidelines illustrate the preferred layout and content of patent applications filed under 35 U.S.C. 111(a). These guidelines are suggested for the applicant's use.

See also 37 CFR 1.77 and MPEP § 608.01(a).

#### **Arrangement and Contents of the Specification**

The following order of arrangement is preferable in framing the specification. See also MPEP § 608.01(a).

(D) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc and an incorporation-by-reference of the material on the compact disc. For computer listings filed on or prior to March 1, 2001, reference to a "Microfiche appendix" (see former 37 CFR 1.96(c) for Microfiche appendix).

### ***Claim Rejections - 35 USC § 112***

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3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 9, 10, and 12 are rejected under 35 U.S.C. 112, first paragraph, because the

specification, while being enabling for “an instruction-insertion server comprising a

processor...”, does not reasonably provide enablement for “an instruction-insertion server...”.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to enable the invention commensurate in scope with these claims.

See Single Means Claim (2164.08(a))

A single means claim, i.e., where a means recitation does not appear in combination with

another recited element of means, is subject to an undue breadth rejection under 35

U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197

(Fed. Cir. 1983) (A single means claim which covered every conceivable means for

achieving the stated purpose was held nonenabling for the scope of the claim because the

specification disclosed at most only those means known to the inventor.). When claims

depend on a recited property, a fact situation comparable to Hyatt is possible, where the

claim covers every conceivable structure (means) for achieving the stated property (result)

while the specification discloses at most only those known to the inventor.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing

to particularly point out and distinctly claim the subject matter which applicant regards as the

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invention. Claim 9 recites “a software program capable of generating a processor...”. Claim 9 could be rephrased to state, “a software program capable of programming a processor...”

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 2, 4-6, 8-11, 13, 14, 16-18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,896,521 to Shackleford et al.

Per claims 1 and 13:

-transmitting, using a software application, a state-accessing instruction stream to an agent in the configurable processor, the software agent being capable of interpreting that stream; and causing using the state-accessing instruction stream, the interpreting agent to return the state of the processor to the software application. (Fig. 12, 13, col. 15, line 60-col. 16, line 20.)

Per claims 2, 6, 14, and 18: (Col. 3, lines 52-56.)

Per claims 4, 8, 16, and 20: (Figs. 1 & 32, col. 21, lines 34-49, col. 22, lines 8-12, col. 3, lines 45-46.)

Per claims 5 and 17: (Fig. 32, col. 21, lines 35-57.)

Per claim 9: (Col. 21, lines 46-49.)

Per claim 10: (Col. 2, lines 9-13.)

Per claim 11: (Fig. 14 and col. 17, lines 10-15.)

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Shackleford disclosed an invention and method for configuring a processor, accessing state information and monitoring / interpreting the configuration program. Shackleford did not disclose an "instruction insertion server" for interpreting the configuration, nor the topology information. Madduri did disclose a debug interface between a host (server) and target system that inserts instructions for monitoring. Madduri's client / server is aware of the topology through the serial connector to the host system.

Per claims 3, 7, 15 and 19: (Madduri: Col. 4, lines 63-66 and col. 5, lines 5-7.)

Per claim 12: (Madduri: Col. 5, lines 1-7 and col. 9, lines 56-58.)

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to have modified Shackleford's invention for a processor synthesis system and method to include a networked arrangement because client / server environments are useful for software development in the industry to access a plurality of machines quickly.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Steelman, whose telephone number is (703) 305-4564. The


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examiner can normally be reached Monday through Thursday, from 7:00 A.M. to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (703) 308-4789.

The fax phone numbers are (703) 746-7240 for regular communications and (703) 746-7239 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

MS 

05/02/2003

  
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